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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,494	12/22/2000	Robert C. Hankinson	93-00-001 (014208.1385)	8279

7590 07/23/2004
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EXAMINER

GRAYSAY, TAMARA L

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 07/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/747,494

Applicant(s)

HANKINSON, ROBERT C.

Examiner

Tamara L. Graysay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:
 - a. Page 3, line 6, “efficiently” is grammatically incorrect.
 - b. Page 6, lines 9-11, and page 14, line 17, please describe Figures 2A and 2B separately. It is suggested that “Figure 2” be changed to --Figures 2A and 2B--.
 - c. Page 7, line 17, “perform” is grammatically incorrect.
 - d. Page 12, line 29, “monitor” should be --reviewer--.
 - e. Page 19, line 6, “45” should be --44--; lines 8, 13, and 17, “246” should be --248--; line 14, “248” should be --250--. (See Figure 2A)
 - f. Page 20, line 9, “44a” should be --48a--.
 - g. Page 21, line 7, “48” should be --48c--; line 13, “40” should be --30--.
 - h. Page 22, first paragraph, for consistency “114” should be --114a-- when referring to successor project owner and --114b-- when referring to predecessor project owner.
 - i. Page 22, line 11, “database 44” should be --database 40--.
- Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1, 4, 6, 8-14, and 29-37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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The basis of this rejection is set forth in a two-prong test: (1) whether the invention is within the technological arts; and (2) whether the invention produces a useful, concrete, and tangible result.

As to the first prong, for a claimed invention to be statutory the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, even though process claims 1, 6, 8-14, and 29-37 include a practical application of producing a modified project file and initiating a corrective action request, the claimed process lacks a tie to any technological art. The process claims do not recite any limitations that involve a technology, and the claimed process steps do not require use of any technology to implement the invention.

Further, mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process. The claimed process must utilize technology in a non-trivial manner. In the present case, even though the process of claim 4 applies, involves, or uses technology by displaying the contract on a website, it is a nominal use of computer-related technology and falls short of non-trivial utilization of technology.

As to the second prong, for a claimed invention to be statutory the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces a modified project file and initiates a corrective action request.

In conclusion, process claims 1, 4, 6, 8-14, and 29-37 meet the second prong of the two-prong test because they produce a useful, concrete, and tangible result, however, they do not meet the first prong because they are not within a technological art, as explained above. Therefore, process claims 1, 4, 6, 8-14, and 29-37 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4-16, and 18-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over the LeRouge article "Managing by Projects" in view of the Atkinson et al. article "A Stakeholder Approach to Strategic Performance Measurement."

Regarding claims 1, 15, 29, 34, and 36, LeRouge discloses a method and system for implementing a project in an organization comprising several phases: an initiation phase, a planning phase, an execution and controlling phase, and a closing phase. LeRouge discloses that the management-by-project method and system have certain capabilities. The method and system include receiving and storing data in a database insofar as there is a discussion of tools to store and retrieve project information and a discussion of database alteration (project software

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tools to store and retrieve project information, e.g., p.71, c.1; database alteration, e.g., p.72, c.1-2; sentence spanning p.73-74). The method and system include monitoring and reports, for example, determination whether the project is progressing in accordance with timelines and costs, for example (monitoring and alert capabilities, e.g., p.71, c.3; p.72, c.1; p.73, c.3). Further, the method and system include corrective action (real-time adjustments, e.g., p.71, c.1; profit planning and accountability, e.g., p.70, c.3)) and modifying the database in response to a corrective action (database alteration, e.g., p.72, c.1-2; sentence spanning p.73-74). Although LeRouge does not explicitly teach the use of a corrective action request, LeRouge does discuss the need for and advantage of “real-time adjustments” (p.71, c.1) to a project. Adjustments of this type are a form of corrective action. LeRouge discloses the use of database alteration, therefore, it would have been inherent in the LeRouge management-by-project system that at least one database would be used to store and retrieve information about each project.

LeRouge does not explicitly disclose the use of a contract to represent the agreement between the organization and project owner (project manager), however, LeRouge does discuss to the use of contract management (e.g., p.73, c.3), detailed employee and project information to determine resource allocation across projects and the use of project software tools to store and retrieve project information (p.71, c.1).

Atkinson et al. disclose the use of an employment contract (performance measurement) to test and manage the relationship between the employee and the organization. Performance measurement includes monitoring and reporting performance in terms of implementation of organization plans (p. 30 c. 1, p. 31, c.1). It is inherent in contractual relationships that the contract parameters are stored in a file, whether the file is a computer database or a paper file. It

is well known that the success of contractual relationships is determined by comparison of a party's performance to the contract terms. It is also inherent in contractual relationships that a breach or failure to comply with contract terms gives rise to penalizing the breaching or non-complying party. The examiner takes official notice that the extent of the penalty against a non-complying party may be part of the contract terms and may result in contracting with a different party.

It would have been obvious to modify LeRouge as taught by Atkinson et al. to include a contract or agreement between the project owner (project manager) and the organization in order to reinforce the importance of performance and to measure the employee performance against the objectives of a particular project.

Regarding claims 2, 4-8, 16, and 18-22, LeRouge discloses the step of displaying information that is relevant to a project owner's responsibilities (accessibility, e.g., p.70, c.3). The information is accessible by employees who would be reviewing the progress of the project including executives. And LeRouge discloses the use of templates (work breakdown templates, e.g., p.71, c.3) for various project components.

Regarding claims 9, 23, 31, and 32, LeRouge discloses the step of associating the project with a budget and schedule (on-time and on-budget performance, e.g., p.70, c.1; p.76, c.2).

Regarding claims 10, 24, and 30, LeRouge discloses an association with a benefit realization plan (profit planning, e.g., p.70, c.3).

Regarding claims 11, 25, and 35, LeRouge discloses modification of an agreement and saving the modifications on the database (change-order updates, e.g., p.73, c.3).

Regarding claims 12 and 26, LeRouge discloses that the management by project method and system may be integrated with payroll (p.76, c.3, 1.18-29). LeRouge is silent as to the particular enforcement division for project owner penalties. The examiner takes official notice that it is the responsibility of an organization's payroll department to compensate employees through salary and benefits. Moreover, the payroll department disperses compensation as determined by the organization. It would have been obvious to one of ordinary skill in the art to modify the method and system of LeRouge and Atkinson et al., to include enforcement of a penalty to the project owner (project manager) by the payroll department as deemed appropriate by the executive staff within the payroll integration in order to ensure that an employee's salary is adjusted in accordance with executive staff directives.

Regarding claims 13, 27, and 37, LeRouge discloses project termination upon completion of the project (closing phase, e.g., p.72, c.1).

Regarding claims 14, 28, and 33, LeRouge discloses the use of a project owner (project manager) for a particular project. It is inherent that if a project owner leaves an organization, is promoted, or is assigned to other duties, then a successor project owner would step in and the database would reflect the change.

4. Claims 3 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeRouge and Atkinson et al. as applied to claims 1 and 15, respectively, above, and further in view of the Theofanos et al. article "Digital Signatures: Signing and Notarizing Electronic Forms."

LeRouge as modified by Atkinson et al. does not disclose the use of electronic signatures when a project owner accepts the organization's project contract or agreement.

Theofanos et al. disclose the benefit of using electronic signatures with electronic business records. The use of electronic signatures in place of a handwritten signature increases the trustworthiness and protects the authenticity and security of the electronic business records.

It would have been obvious to one of ordinary skill in the art to modify the method and system of LeRouge to include the use of electronic signatures for the contract or agreement between the organization and project owner, as taught by Theofanos et al., in order to increase the trustworthiness and to protect the authenticity and security of the contract or agreement between the organization and the project owner for every project.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Wollaston et al. disclose a method and system for tracking events, reporting employee performance and activities, storing and retrieving database information, and project reassignment capabilities.
- b. Nummelin et al. disclose a project management system using at least one database for storing and retrieving information about a project.
- c. Jury et al. discloses the use of a project manager (project folder manager) to control interactions between the database and user, and the use of templates (boilerplate file) for project.
- d. Kenny et al. discloses a method and system for generating reports and monitoring project progress for an entity, which may include an individual. The use of the method

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and system is to motivate employees and customers to perform consistent with project objectives.

e. Barkowski discloses a method and system for planning, budgeting, scheduling and monitoring projects. The method and system include storing the information in and retrieving the information from databases.

f. Simons discloses a formal management control system and method used by a top-level executive to implement a strategic plan. Implementation of the strategic plan using the control system and method permits organizational change or stability commensurate with mission statements. The control system and method include planning guidelines, monitoring compliance with a plan, and taking corrective action when necessary to ensure organizational activities are maintained or altered.

g. Dalton discloses establishing and managing performance-based (purchasing) contracts electronically, including templates (boiler-plate language), and electronic signature capability.

h. Bassolino et al. discloses a strategy for ensuring employee compliance with an employment contract by linking penalties for contract non-compliance to employee housing funds and other company benefit plans.

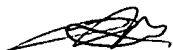
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is (703) 305-1918.

The examiner can normally be reached on Monday - Friday from 8:30am to 5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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